

REMARKS

Applicant has carefully reviewed the office action mailed November 28, 2003. Applicant respectfully requests that the Examiner reconsider the finality of that office action. In support of this request, Applicant directs the Examiner's attention MPEP 706.07(a) which provides that "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground for rejection that is not necessitated by applicant's amendment."

In the present case, the Examiner introduced a new ground for rejection on page 2 of the office action mailed November 28, 2003 by indicating (for the first time) that in rejecting claim 32 the Examiner is "in-fact relying on the affidavit signed on July 24<sup>th</sup>, 2003 (sic)." This ground for rejecting claim 32 was not identified in the office action mailed May 2, 2003, which stated on page 6: "Claims (sic) 32 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by [the] (sic) Affidavit signed by Alexander Shek, Feb 16, 2001."

Because the Examiner introduced the affidavit signed on July 24<sup>th</sup>, 2001 as a new ground for rejecting claim 32 in the office action mailed November 28, 2003, and because this affidavit was not identified as a ground for rejecting claim 32 in the office action mailed May 2, 2003, Applicant respectfully requests that the Examiner reconsider the finality of the last office action.

In the office action mailed November 28, 2003, Claims 32, 36-42 and 48 were rejected under 35 U.S.C. § 102(b) as being anticipated by affidavits executed by Alexander Shek on February 16, 2001 and July 24, 2001. On page 2 of the office action, the Examiner indicates that "public use is clearly shown" by the affidavits. Accordingly, Applicant interprets this rejection

as being based on the premise that “the invention was . . . in public use . . . in this country, more than one year prior to the date of application for patent in the United States.” 35 U.S.C. 102(b).

On page 2 of the office action, the examiner notes that “Applicant’s arguments are based on the premise that the company representing Shek did not ever publicly disclose the method of producing these lithophane articles.” The Examiner then provides a counterargument to Applicant’s premise. In an effort to understand the Examiner’s counterargument, Applicant has reduced the counterargument to the follow syllogism:

MAJOR PREMISE: A method is in public use if it is known by one person other than the original inventor.

MINOR PREMISE: Shek’s method of making lithophanes was know to at least one person other than the original inventor.

CONCLUSION: Therefore, Shek’s method of producing lithophanes was in public use.

The major premise (shown above) states; a method is in public use if it is known by one person other than the original inventor. Applicant derived this major premise from the Examiners statement on page 2 that, “[t]he method of production of these articles is likewise known by the public if it is known by one person (Shek qualifies as this person) other than the inventor, who is unknown.”

This major premise is inconsistent with the public use standard found in the Manual of Patent Examining Procedure. More particularly, MPEP Sec. 2133.03(a) provides that “[m]ere

knowledge of the invention by the public does not warrant rejection under 35 U.S.C. 102(b).” “35 U.S.C. 102(b) bars public use or sale, not public knowledge.” Because the major premise applied by the Examiner is inconsistent with the rule provided by the MPEP, this major premise is false.

The minor premise (shown above) states; Shek’s method of making lithophanes was know to at least one person other than the original inventor. On page 2, the Examiner directs Applicant’s attention to the appendix of the Shek Affidavit dated Feb. 14, 2001. This appendix contains three invoices that are described briefly below:

Exhibit AS1 is an invoice that purports to show that Shek (doing business as Computerized Manufacturing Services) sold one or more Lithophane Master Engravings to another person.

Exhibit AS3 is an invoice that purports to show that Shek (doing business as Machining Data Tech) purchased 2,600 Acrylic Lithophanes from another person.

Exhibit AS5 is an invoice that purports to show that Shek (doing business as Specialty Image) sold 340 Solid Oak Legend of the West Light Boxes to another person.

These invoices show that Shek was engaged in various transactions with other persons. These invoices do not show, however, that any of these other persons disclosed a method for making lithophane molds to Shek (or vice-versa). Paragraph 2 of the Shek Affidavit dated Feb. 14, 2001 states that Shek’s company “has been engaged in the manufacture of plastic injections moulds and precision machining since its inception in 1993.” In light of this fact, it seems unlikely that Shek learned a method for making lithophane molds from one of his customers or vendors.

On page 2 of the last office action, the Examiner observes that “[t]he Shek affidavits do not claim that Shek or the company represented by Shek to be the original inventor(s) of this lithophane article and method of making.” This observation seems to lead the Examiner to the conclusion that Shek did not invent the methods described in his affidavit. One way to reach this conclusion is illustrated in the three steps listed below:

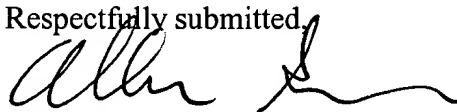
- STEP 1: The Shek affidavits show that Shek knew of the methods described therein.
- STEP 2: “The Shek affidavits do not claim that Shek or the company represented by Shek to be the original inventor(s) of this lithophane article and method of making.”
- STEP 3: Therefore, Shek qualifies as a person (other than the original inventor) who knows of the method.

The reasoning illustrated in these three steps is flawed because it ignores the possibility that Shek and the original inventor are the same person. Because the Shek affidavits are silent with regard to inventorship, they provide no factual basis for concluding that Shek did not invent the methods described therein. Because the minor premise (stated above) is not supported by any facts in the current record, and because the major premise (stated above) is inconsistent with the standard found in the MPEP, the Examiner has not shown that a conclusion of public use is supported by the references cited in the instant rejection.

Under 35 U.S.C. § 102(b), a person is entitled to a patent unless the claimed invention was in public use more than one year prior to the date of the application for patent. Because Applicant's invention, as recited in claim 32, is a method and because the Shek affidavits fail to allege the public use of any method, Applicant's claimed invention is not anticipated by the activities described in the Shek Affidavits. Claims 36-48 depend from Claim 32 and recite additional limitations. Applicant respectfully submits that these dependent claims are also in condition for allowance.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested. The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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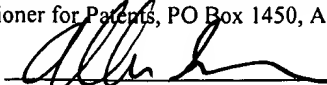
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